

REMARKS

Recapture under 35 U.S.C. § 251

The examiner has rejected claims 16-18 and 20-28 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application
5 for the patent upon which the present reissue is based. The examiner identifies three areas of potential recapture revolving around base claims 16 and 18. In response, claims 16 and 18 as amended herein are not believed to recapture surrendered subject matter.

In order for an improper recapture to occur, the reissue claim must be as broad as or broader than a cancelled or amended claim in an aspect germane to a prior art rejection. *In*
10 *re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997).

With respect to the first potential recapture area, claims 16 and 18 are amended herein to reflect the limitation of the pad extending “beyond” the base panel. However, there is no recapture as to the other two areas identified by the examiner.

With respect to the second area, the limitation requiring the pad to fit “on top of” the
15 cover introduced in the amendment file 2/5/01, the applicant points out that new claim 13 was also introduced in the 2/5/01 amendment without this limitation.¹ Claim 13 included the limitation of the pad extending beyond the base panel, but did not include either of the other two areas of potential recapture (i.e., the pad “on top of” the cover, nor the “gap” between the walls, discussed next). In fact, claim 13 did not include any cover element at
20 all, much less a pad fitting on top of it. A separate dependent claim (15) introduced at the

¹ Claim 13 was later allowed with minor grammatical changes.
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same time included the cover and the “on top of” limitation. Thus, the limitation of the pad fitting on top of the cover was not present in a broad allowed claim (13) containing no other limitations germane to the office action. Here, amended claims 18 is narrower than claim 13 because it includes the additional limitation of a cover, not present in claim 13. Claims 16 and 18 have also been amended, as mentioned above, to include the limitation of the pad “extending beyond” the base. Accordingly, there is no recapture of the “on top of” limitation in amended claims 16 and 18 herein.

Finally, with respect to the third limitation concerning the “gap” between the second side wall and the end wall, it must be remembered that there were two distinct embodiments of the support unit of the invention: (a) a first embodiment having a base, a single end wall and two side walls (claims 1-7, 13-15), and (b) a second embodiment having a base, two end walls, a complete sidewall, and a partial sidewall (claims 8-12). The limitation of the “gap” between the partial side wall and the second end wall is only applicable to the second embodiment, and is completely missing from the other claims directed to the other embodiment, particularly claims 1 and 13. Thus, this limitation was not germane (nor even possible) in the first embodiment to which claims 16 and 18 are also drawn. Thus, the absence of this limitation from claims 16 and 18 is not a recapture of surrendered subject matter.

Claim Objections

The examiner has objected to claim 19 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims. Claim 19 has been so amended, and is now believed to be in condition for allowance.

The examiner has objected to claim 23 because “said cover extension” lacks antecedent basis. In response, claim 21 (from which claim 23 depends) has been amended to depend from claim 19, providing proper antecedent basis. Since claim 19 is now believed to be in condition for allowance, claims 21 and 23 are also believed to be in condition for allowance.

The examiner has objected to claim 26 because “said inside surfaces” lacks antecedent basis. This claim has been amended to provide such basis.

Finally, the examiner has objected to the phrase “the left edge” in claim 31. This phrase has been deleted.

Rejection Under 35 U.S.C. § 102(b)

The examiner has rejected claim 31 under 35 U.S.C. § 102(b) as being anticipated by Lerner (U.S. 3,336,608). In response, the applicant has amended claim 31 to include the limitation of the pad extending beyond the base panel, a feature that is not disclosed in Lerner.

Rejections Under 35 U.S.C. § 103(a)

The examiner has rejected claims 16-18, 21 and 26-27 under 35 U.S.C. § 103(a) as being unpatentable over Antosko (US 5,115,524) in view of Linge (US 5,675,853). As indicated previously, claims 16-17 have been cancelled. Claim 18 has been amended to include the limitation of the pad extending beyond the base panel. Neither Antosko nor

Linge disclose or teach providing such an extended pad. Thus, claim 18 is believed to be in condition for allowance. Claim 19 was only objected to, and has been amended to include the limitations of base claim 18. Claims 21 and 26-27 have been amended to depend from claim 19. Thus, these claims are believed to be in condition for allowance.

5 The examiner has rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Antosko and Linge in further view of Butler III (US 5,551,108). In response, the applicant has amended claim 25 to depend from allowable claim 19.

 The examiner has rejected claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Antosko and Linge in further view of Dishart (US 3,269,621). In response, the
10 applicant has amended claim 28 to depend from allowable claim 19.

 The examiner has rejected claims 16-18, 21, 26-27 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Lerner (US 3,336,608) in view of Linge (US 5,675,853). As indicated previously, claims 16, 18 and 31 have been amended to include the limitation of the pad extending beyond the base panel. Neither Lerner nor Linge disclose or teach
15 providing such an extended pad. Thus, claims 16 and 18 are believed to be in condition for allowance. Claim 19 was only objected to, and has been amended to include the limitations of base claim 18. Claims 21 and 26-27 have been amended to depend from claim 19. Thus, these claims are believed to be in condition for allowance.

 The examiner has rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable
20 over Lerner and Linge in further view of Butler III (US 5,551,108). In response, the applicant has amended claim 25 to depend from allowable claim 19.

The examiner has rejected claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Lerner and Linge in further view of Dishart (US 3,269,621). In response, the applicant has amended claim 28 to depend from allowable claim 19.

New Claims

5 New claims 33-75 are added by this amendment. No new matter has been introduced with these claims, and the antecedent basis for each claim is identified below.

 Claim 33 is directed toward an embodiment of the invention having a fabric cover that extends beyond the opposite end of the base panel. Antecedent basis is found in the specification at column 4, lines 20-27 and Fig. 8. Claim 34 depends from claim 33 an a pad
10 placed over the cover. Antecedent basis is found in the specification at column 4, lines 27-33.

 Claim 35 is directed toward an embodiment of the invention having a plurality of openings on the back of the base panel for receiving suction cups, the cover having openings corresponding thereto. Antecedent basis is found in the specification at column 4,
15 lines 42-47.

 Claim 36 is directed toward an embodiment of the invention having a pair of slots for receiving a securement belt, the cover having openings corresponding thereto. Antecedent basis is found in the specification at column 4, lines 48-49.

 Claim 37 is directed toward an embodiment of the invention having a night light in
20 the end wall, the cover having a corresponding opening. Antecedent basis is found in the specification at column 4, lines 61-62.

Claims 38-39 are dependent on allowed claim 29 and includes slots for receiving a securement belt, and openings in the cover for the slots. Antecedent basis is found in the specification at column 4, lines 48-49.

5 Claim 40 is dependent on allowed claim 30 and includes openings in the cover for the straps. Antecedent basis is found in the specification at column 5, lines 9-15.

Claim 41 is dependent on allowed claim 29 and includes outside pockets. Antecedent basis is found in the specification at column 4, lines 51-55.

Claim 42 is dependent on allowed claim 29 and includes outside pockets. Antecedent basis is found in the specification at column 4, lines 56-60.

10 Claim 43 is dependent on allowed claim 29 and includes a night light. Antecedent basis is found in the specification at column 4, lines 61-62.

Claim 44 is dependent on claim 43 and includes openings in the cover for the night light. Antecedent basis is found in the specification at column 4, lines 61-62.

15 Claim 45 is dependent on allowed claim 29 and includes a removable wedge for supporting an infant's body. Antecedent basis is found in the specification at column 3, lines 15-19.

Claim 46 is dependent on allowed claim 29 and includes a removable cover for the pad. Antecedent basis is found in the specification at column 2, lines 4-6.

20 Claim 47 is dependent on allowable claim 19 and includes a securing strap. Antecedent basis is found in the specification at column 5 lines 9-11, and col. 3, lines 5-7.

Claim 48 is dependent on allowable claim 19 and includes an opening in the cover. Antecedent basis is found in the specification at column 2 lines 65-66.

Claim 49 is dependent on allowable claim 19 and includes a zipper. Antecedent basis is found in the specification at column 2 lines 57-58, and column 4, lines 35-37.

5 Claim 50 is dependent on allowable claim 19 and includes interengaging hooks and loops (Velcro). Antecedent basis is found in the specification at column 4 lines 35-37.

Claim 51 is dependent on allowable claim 19 and includes a night light. Antecedent basis is found in the specification at column 3, lines 8-10, and column 4, lines 61-62.

Claim 52 is dependent on claim 51 and refers to openings for the night light.
10 Antecedent basis is found in the specification at column 3, lines 8-10, and column 4, lines 61-62.

Claim 53 is dependent on allowable claim 19 and includes a removable wedge for supporting an infant's body. Antecedent basis is found in the specification at column 3, lines 15-19.

15 Claim 54 is dependent on allowable claim 19 and includes a removable cover for the pad. Antecedent basis is found in the specification at column 2, lines 4-6.

Claims 55-61 refer to the support unit having a base with an upwardly disposed end and two upwardly disposed sides, and an outwardly extending pad.

Claims 62-68 refer to the support unit having a base with an upwardly disposed end
20 and two upwardly disposed sides, having an outwardly extending cover.

Claims 69-75 refer to an alternative embodiment of the invention in which the support unit has a base, two upwardly disposed ends, an upwardly disposed complete side, and an upwardly disposed partial side, together with a pad that fits between them.

Allowed Claims

5 The examiner has allowed claims 1-15, 29-30. Claim 19 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 19 has been so amended, and is now believed to be in condition for allowance. Likewise, the claims which depend from claim 19 (claims 20-28 and 47-54) are also believed to be in
10 condition for allowance.

Summary

A total of 75 claims are present as a result of this amendment, of which 17 are independent claims. Payment for 32 total claims including 10 independent claims has previously been made. Thus, a check in the amount of \$1,775 is enclosed representing the
15 total small entity fee comprising:

- (1) the independent claims fee of \$700 for the 7 new independent claims in excess of three at \$100 each (37 C.F.R. § 1.16(i)), created or added by this amendment; and
- (2) a fee of \$1075 for the 43 claims in excess of those already paid for at \$25 each (37 C.F.R. § 1.16(j)).

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Authorization to Charge Additional Fees

The Office is hereby authorized to charge deposit account number 502429 for any additional fees that may be required by this paper.

In view of the above, it is submitted that all claims are in condition for allowance.

5 Allowance of the claims at an early date is solicited.

The examiner is encouraged to contact the undersigned by telephone to resolve any outstanding issues concerning this application.

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Respectfully Submitted,

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